

Applicant : Scott D. Hardy
Serial No. : 10/774,895
Filed : February 9, 2004
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Attorney's Docket No.: 10762-006001

Amendments to the Drawings:

In Figure 2 (replacement sheet attached herewith), we have amended the drawing so as not to have redundant reference numbers.

Applicant has added figures 8A through 8C (attached herewith), to bring claims 14, 15 and 17 into compliance with 37 C.F.R. §1.83. No new matter has been added.

Attachments following last page of this Amendment:

1 Replacement Sheet and 2 New Drawings

REMARKS

Interview Summary

The applicant thanks Examiner Mayo for the January 5, 2006 interview between Examiner Mayo, applicant Scott Hardy, and applicant's attorney Frank Occhiuti. During the interview, the propriety of the combination of prior art references under 35 U.S.C. §103(a) was discussed.

Amendments to Specification

We have amended the specification to replace a redundant reference number and conform to the amended and new drawings.

New Claims

Applicant has added new claims 28-30. Applicant believes these claims to be patentable at least for the reasons described below.

New Drawings

We have amended Fig. 2 so as not to have redundant reference numbers. Specifically, we have replaced one of the references to "38" with --39--. Applicant has also added figures 8A through 8C (attached herewith), to bring claims 14, 15 and 17 into compliance with 37 C.F.R. §1.83. No new matter has been added. With respect to the Examiner's objection claim 16, we submit that the feature recited in this claim is shown in figure 2.

Formal Objections

Applicant has amended claims 13-17 in response to Examiner's formal objections.

Rejections over Prior Art

Examiner has rejected claims 2-6, 8-13, 15, 18-22, and 24-27 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,291,623 (Artz) in view of U.S. Patent No. 4,739,527 (Kohus).

With regard to independent claim 11, Examiner concedes that Artz fails to teach a protective member sealing the inner, inflatable panels from the child, as recited in claim 11. Examiner maintains that Kohus teaches this feature (i.e., protective panels 162), and that one of skill in the art would be motivated to modify Artz to incorporate the teachings of Kohus in order to prevent a child from becoming trapped in the corner upon accidental collapse of the device.

We disagree. Neither Artz nor Kohus, separately or in any proper combination, suggest the desirability of preventing a child from becoming trapped in the corner upon accidental collapse of the device found. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (see MPEP 2143.01(I)).

Kohus describes a portable foldable playpen with rigid support legs. In this context, the protective panels of Kohus accomplish another task: "a child is protected *from engagement with the legs* by the inner protective panel 163." (Column 9, lines 56-58.) However, in the structure according to the pending claims, a child need not be protected from engagement with any part of the structure, since the structure is not rigid. Thus, one of ordinary skill in the art would not be motivated to modify Artz to employ the protective panels of Kohus.

The rejection is a hindsight reconstruction, using applicant's claim as a template to reconstruct the invention by picking and choosing isolated disclosures from the prior art. This is impermissible under the law. For example, in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1600)

The present rejection fits the court's description of what may not be done under §103. The Examiner has merely listed certain components of applicant's invention and then located isolated disclosures of those components. The law requires more than that.

The Examiner must show where the prior art provides a motivation to combine the references he/she has combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As the Federal Circuit stated in Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

With regard to claim 8, Examiner asserts that it would be obvious to one of ordinary skill in the art to make the lower ends of each of the side panels of the device shown by Artz and Kohus wider than their upper ends. Examiner asserts one of ordinary skill would be motivated to do so in order to further stabilize the structure against over-tipping by lowering the center of gravity. However, nowhere in the cited references is this taught or suggested. To the extent Examiner regards this as "common knowledge," we maintain that such a motivation is improper. In reversing the Board of Patent Appeals and Interferences, on a rejection involving "common knowledge," the Federal Circuit cautioned:

As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience--or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

In re Zurko, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001).

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable. Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the Examiner does not mean that the applicant concedes other comments of the Examiner, (b) made

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arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the Examiner's positions with respect to that claim or other claims.

Enclosed is a \$50.00 check for excess claim fees (We cancelled independent claim 1 and added independent claim 30; therefore, we believe no independent claim fee is due. However, enclosed is a check for the two new dependent claims 28 and 29.). Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket Number 10762-006001.

Respectfully submitted,

Date: January 23, 2006



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